REMARKS:

Claims 35, 37, 38, 40-45, 47, 51 and 113-115 are pending in which claims 35 and 113 are independent claims.

Claims Rejections under 35 USC 103

Claims 35, 37-39, 41-45, 47, 51 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rueda (6,157,727) in view of Takebayashi et al. (5,577,165). Applicant filed a 131 declaration to overcome Rueda in response to the previous Office Action mailed February 15, 2008. The Examiner objects to the exhibits attached to the declaration as failing to comply with the language requirements because the exhibits are in Japanese. Applicant does not believe that any rule requires Applicant to submit translations of foreign language documents, while Applicant understands that the rule does not prohibit the Examiner from requesting translations of the foreign language documents.

Applicant is an independent inventor and has a limited financial resource. Instead of having all the exhibits translated at once, therefore, Applicant herewith submits a translation of the pertinent section of Exhibit A so as to have the Examiner first determine on Applicant's prior conception of the present invention. If the Examiner's determination is positive, Applicant will have the rest of the exhibits translated.

The Examiner finds, without articulating any bases therefor, that performing one's duties at a place of employment is not a sufficient excuse for inactivity in reduction to practice. There is no rule requiring a specific kind of activity in determining whether the applicant was reasonably diligent in proceeding towards an actual or constructive reduction to practice. *Brown v. Barbacid*, 436 F.3d 1376, 1380 (Fig. Cir. 2006). "[E]xercise of reasonable diligence ... does not require an inventor to devote his entire time thereto, or to abandon his ordinary means of livelihood." *Griffith v. Kanamaru*, 816 F.2d 624, 627 (Fed. Cir. 1987) (citing *Courson v. O'Connor*, 227 F. 890 (7th Cir. 1915).

In *Courson v. O'Connor,* the last experiment to determine whether the invention worked as expected was made by Courson on October 17, 1908, and the application

was filed on February 8, 1909. However, Courson offered to the Patent Office no evidence to explain the delay in filing the application or to establish diligence. The Patent Office held that the absence of evidence led to the conclusion of lack of diligence.

On appeal, Courson came forward with evidence to explain the delay in filing the patent application after the October 17, 1908 experiment. According to Courson, a week after the October experiment, he called on his lawyer, Gray, to recommend a patent attorney for Courson. But Gray was not in the office. In early November, Courson again called on Gray, who mentioned a patent attorney, Clarke. But Courson could not retain Clarke until mid December. Also, due to the inability of a draftsperson and the tight schedule of Clarke, Courson could not file the application until February.

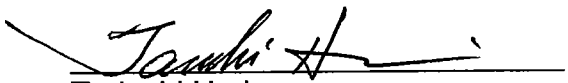
The fact is that Courson was at the head of a large and important shop in charge of nearly 3,000 men. The court seems this evidence sufficient to constitute an excuse for the inactivity. The Court noted that Courson's time was not his own and that unless he gave up his position, he could ordinarily devote only his own time, not his employer's time to his invention ("He could go to his attorney's office, not when he desired, but when the work at the shop made it convenient"). The court continued that if Courson was to retain his important and highly responsible position with the railroad, he was necessarily compelled to make the perfecting of this invention and the preparation for his patent subordinate to his other pressing daily activities. In affirming the diligence by Courson, the court condemned the lower court's criticism against Courson that his invention received only such attention Courson was able to give it after the full discharge of his immediate obligations to his employer.

Applicant of the present application, Dr. Toshio Oba, is a medical doctor. While being hired at Yokohama Municipal Citizen's Hospital, he performed a number of operations for five months between June 1998 and October 1998. As indicated in his 131 declaration, he performed 7 operations in June 1998, 8 operations in July 1998, 8 operations in August 1998, 7 operations in September 1998 and 8 operations in October 1998. During the five months, he literally devoted most of his time to discharging his responsibilities as a medical doctor at the hospital.

Yokohama Municipal Citizen's Hospital is one of the largest hospitals in Yokohama city, where more than 3 million people live. At the hospital, Dr. Oba was responsible to see outpatients and inpatients every day for more than 8 hours. An operation usually began at 8:00pm or 9:00 pm after Dr. Oba completed examination of all of his out- and inpatients. An operation took about three hours when it was minor but took more than 12 hours when it was major. About one third of the operations Dr. Oba performed were major operations. It was not uncommon that these major operations required his continuous labor through the night till the morning of next day. It should be noted that Dr. Oba usually did not have any choice on the dates of these major operations because patients in critical condition could not be kept waiting.

Given the responsibilities as a medical doctor and the hard labors, Dr. Oba's performing his duties at the hospital should be recognized as a legitimate excuse for inactivity according to *Courson*. Reconsideration is respectfully requested.

Respectfully submitted,



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